

## **REMARKS**

Claims 25-162 were pending and presented for examination and in this application. Claims 51-58 and 60-81 were withdrawn from consideration. In an Office Action dated September 25, 2007, claims 25-50, 59, 82-162 were rejected and claims 140 and 141 were objected to. Applicants are amending claims 25, 26, 28, 29, 30, 43, and 105. Applicants also are cancelling, without prejudice, claims 51-58, 60-81, 108-111 and 129-162. No new claims have been added. In view of the Amendments herein and the Remarks that follow, Applicants respectfully request that Examiner reconsider all outstanding objections and rejections, and withdraw them.

### **Statement of Interview**

Applicants also thank Examiners Melur Ramakrishnaiah and Curtis Kuntz for arranging an interview on November 9, 2007, between Examiner Ramakrishnaiah and Douglas Luftman (in person), head of Intellectual Property for assignee Palm, and Rajiv Patel (telephonic), representative of assignee Palm. As required by 37 C.F.R. § 1.133 and MPEP § 713.04 and agreed upon with Examiner, the substance of the interview is incorporated in this amendment and response.

Specifically, as discussed in the Examiner interview, Applicants are amending claims 25 and 43 as set forth herein. Further, Applicants are addressing the objection to the claims and the rejection under 35 USC §112 through cancellation of affected claims in order to obviate the basis for such objection and rejection. In addition, as requested by Examiner, Applicants below particularly point out distinctions between the cited references (including Griffen and Motorola Accompli articles) and presented claims.

Finally, Applicants note for record the review with Examiner a demonstration of an Accompli device. The discussion of differences from that demonstration versus the claims is incorporated into this amendment and response.

### **Objection to Claims**

Claims 140 and 141 were objected to due to presentation twice with different limitations. Both claims corresponding to claim 140 and both claims corresponding to claim 141 are cancelled without prejudice. Thus, the basis for this objection now is obviated.

### **Response to Rejection Under 35 USC §112, Paragraph 1**

In the Office Action, Examiner has rejected claim 158 under 35 USC §112, ¶ 1 as allegedly lacking written description. This claim is now cancelled without prejudice, thus obviating the basis for this rejection.

### **Response to Rejection Under 35 USC §103(a)**

In the Office Action, Examiner rejects claims 25-20, 59, and 82-149 under 35 USC §103(a) as allegedly being unpatentable over U.S. Patent 6,489,950 (“Griffen”) in view of either Morotola V100 or Motorola Accompli as described by Pinkerton in Dealerscope November 2000 (“Pinkerton”), DiSabatino in Computerworld November 6, 2000 (“DiSabatino”), Palenchar in Twice October 9, 2000 (“Palenchar”), Orubeondo in InfoWorld April 23, 2001 (“Orubeondo”), Motorola 009 User’s Guide, Motorola “Let’s Start” for 009 and Motorola V100 User’s Guide, and further in view of U.S. Patent No. 6,587,132 (“Smethers”). This rejection now is respectfully traversed.

Applicants have amended the independent claims. Representative claim 43 (discussed with Examiner in interview) recites a device with a telephonic component that includes, *inter alia*, the following:

...  
a plurality of keys arranged in a configuration having key rows oriented perpendicularly with respect to the long axis of the device, one of the key rows comprising successive keys representing the letters Q, W, E, R, T, and Y;

wherein the plurality of keys comprises at least nine multi-value keys, each multi-value key associated with at least a primary value and a numeric secondary value, the at least nine multi-value keys having a common visual characteristic, the at least nine multi-value keys having the common visual characteristic arranged in at least three successive rows and three successive columns, the non-foldable keyboard located below a display screen along the long axis of the handheld device, and

wherein the plurality of keys further comprises an option key configured to set the at least nine-multi-value keys in one of a plurality of states, a first state corresponding to a single use of a numeric secondary value of the multi-value keys, a second state corresponding to consecutive use of any numeric secondary values of the multi-value keys, and a third state corresponding to use of only primary keys of the multi-value keys, and

wherein in response to operation of the wireless telephone the at least nine multi-value keys initially set to the second state and operable as a touch-tone keys.

The claimed invention beneficially recites a device configured for data entry and wireless telephone operations that includes a keyboard that includes consecutive keys with the letters ‘Q’, ‘W’, ‘E’, ‘R’, ‘T’, and ‘Y’ and has keys that are arranged with a telephone dialpad configuration through three multi-value keys in a row and three multi-value keys in a column. The multi-value keys in this dialpad configuration have a primary value (e.g., an alphabet letter) and a secondary value (e.g., a numeric value from “1” through “9”).

To toggle between the primary value and the secondary value, the claimed configuration includes an option key within the plurality of keys, which is configured to toggle between states corresponding to use of the multi-value keys. The first state allows for a single use of a secondary value of the multi-value key, the second state allows for consecutive use of secondary values of the multi-value keys without having to consecutively toggle the option key, and the third state allows for use of only the primary values of the multi-value key. In addition, when the wireless telephone is operational, the multi-value keys are initially set to a second state and the multi-value keys are operational as touch-tone keys. However, even when automatically set to the second state, the claimed option key advantageously permits access to the primary keys by toggling its state from the second state to either the first state or third state.

The claimed configuration beneficially provides multifunction operations from a full alphanumeric keyboard (e.g., “Q-W-E-R-T-Y” keyboard layout) in a confined space. This eliminates the amount of surface area needed for additional keys corresponding to secondary value keys as is found on conventional keyboards. Further, the claimed invention provides for access to the secondary values in multiple modes through an option key that may be toggled between at least three states. Hence, there is no need for dedicated keys or combination of keys to trigger desired states. This further reduces need for surface area on the device. Moreover, the claimed invention is configured to provide access to both values of the multi-value keys even when the device is operational in a second mode (e.g., telephone). The reduced number of keys and surface area contribute to lower overall

manufacturing costs due to fewer parts to assemble and align and use of less materials due to smaller form factor.

As discussed with Examiner, the claimed invention is distinguishable over the cited references. Griffen discloses a two-way text messaging device and it also discloses a device with a QWERTY keyboard layout. (Griffen, col., ll. 48-55; see also col. 2, ll. 61-65 (the Griffen device “permits full-text, two-way messaging such as email messaging.”)). The Griffen specification does not contemplate telephonic integration or features for such integration. As such, the Griffen specification lacks the claimed feature of “plurality of keys compris[ing] at least nine multi-value keys, each associated with at least a primary value and a numeric secondary value, the at least nine multi-value keys having a common visual characteristic, the at least nine multi-value keys having the common visual characteristic arranged in at least three successive rows and three successive columns, and in response to operation of the wireless telephone the at least nine multi-value keys activated for touch tone keypad operation with the wireless telephone.”

Griffen’s reference to a keyboard is in the context of “keys representing the alphabet generally placed as they would appear on a standard keyboard.” The keys are laid out keeping mind the context of maintaining familiarity for the user. (Griffen, col. 1, ll. 50-55). In this context, for a two-way text messaging device maintaining such familiarity would mean that similar to conventional keyboards the number keys must be in a row directly across a top row so that the user maintains that familiar keyboard look and feel. Placing the keys in a number pad configuration would defeat the purpose of what this reference specifically teaches and attempts to achieve. Moreover, because Griffen lacks telephonic

functionality, there is no need for a keyboard that integrates keys within three rows and three columns to form a dial pad arrangement in a manner as claimed.

Nor does the Motorola Accompli device (the V100, Accompli, and their reference in the Pinkerton, DiSabatino, Palenchar and Orubeondo articles) resolve the deficiencies of Griffen.<sup>1</sup> The Motorola device is a mobile communication device that allows separate data entry and telephonic operation. However, beyond the ability to have data entry and telephonic operation on the device, the device is quite different than the claimed invention. In contrast to the claimed invention, the Accompli device is configured similar to a pager and other messaging devices since its “primary purpose is two-way messaging.” (DiSabatino article, p. 44). The Accompli can “be used with a hands-free headset to make wireless phone calls.” (*Id.*). The display and keyboard of the Accompli device is configured to be in a flip format rather than being within one planar axis as is claimed. Further, as illustrated to the Examiner in the demonstration at the interview, the Accompli device is configured for two handed operation. Access to the numbering configuration of 0-9 is only in response to simultaneously pressing two separate buttons - both the ALT and Phone button keys - in order to lock the number pad for use with the phone. (See User’s Guide, Reference 1V, p. 22-23, 80).

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<sup>1</sup> With respect to the Accompli device, Applicants make reference to the applicable art in view of the demonstration of the device and the additional, non-applicable art, cited by the Examiner (note that the Accompli 009 User Guide was published in 2002 and cannot be considered a reliable reference for the features disclosed therein since there is no support to indicate that those features existed prior to 2002). Further, it is once again noted that the referenced articles, merely describe the Accompli device generally and fail to disclose the specifics of what specific features existed at the time of the articles in the context of what is now claimed.

In contrast to the Accompli device, the claimed invention is particularly beneficial for single hand operation of the handheld device as well as use for both wireless telephone and data communication. For example, activation of the keypad layout on the keyboard of the claimed invention allows for touch tone input, for example, when the device is operational as a telephone and the keys are initially set to a second state. Moreover, the claimed configuration allows for a simplified one touch operation to change states between first and second character values on key. Specifically, unlike the Accompli device, the claimed invention includes “an option key configured to set the at least nine-multi-value keys in one of a plurality of states, a first state corresponding to a single use of a numeric secondary value of the multi-value keys, a second state corresponding to consecutive use of any numeric secondary values of the multi-value keys, and a third state corresponding to use of only primary keys of the multi-value keys.” In this claimed configuration single handed operation of the device and the multi-function facet aspects of the key is possible through changeable states.

There are other claimed features that distinguish the claimed invention from the Accompli device. For example, the claimed invention is beneficially configured so that the device is configured for interface within one plane having a long-axis and a short-axis. A benefit of this configuration is when operational as a telephone it allows for the device to be held in the hand similar to a conventional telephone. In contrast, the Accompli device is not appear to be structurally configured for use as a conventional telephone handset. (See Motorola Personal Communicator Let's Start, p. 11). Unlike the claimed invention, the

structural configuration of the Accompli device appears to make it difficult for use as a conventional telephone.

Further, assuming *arguendo* that the Griffen and the Accompli device could be combined, the configuration would still lack at least the claimed “plurality of keys further comprises an option key configured to set the at least nine-multi-value keys in one of a plurality of states, a first state corresponding to a single use of a numeric secondary value of the multi-value keys, a second state corresponding to consecutive use of any numeric secondary values of the multi-value keys, and a third state corresponding to use of only primary keys of the multi-value keys” and also lack the claimed “in response to operation of the wireless telephone the at least nine multi-value keys initially set to the second state and operable as a touch-tone keys.” Hence, for at least these reasons, the claimed invention is patentably distinguishable over these cited references.

Based on the above amendment and the remarks, Applicants respectfully submit that for at least these reasons claims 25, 30, 43, and 105 are patentably distinguishable over the cited reference. Therefore, Applicants respectfully request that Examiner reconsider the basis of the rejection and withdraw it. As to the dependent claims, all arguments advanced above with respect to these claims and are hereby incorporated by reference.



### Conclusion

In sum, Applicants respectfully submit that independent claims 25, 30, 43, and 105, along with their respective dependencies, now are patentably distinguishable over the cited references (including references cited, but not applied). Therefore, Applicants request reconsideration of the basis for the rejections to these claims and request allowance of them.

In addition, Applicants respectfully invite Examiner to contact Applicants' representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,  
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